

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte BRUCE C. LINCOLN

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Appeal No. 2002-0494  
Application No. 29/102,729

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HEARD: June 13, 2002

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Before HAIRSTON, NASE, and GREEN, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the single design claim pending in this design reissue application.<sup>1</sup>

We AFFIRM.

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<sup>1</sup> Application filed March 30, 1999, for reissue of U.S. Patent No. Des. 378,692.

### BACKGROUND

The appellant's invention relates to a design for a transparent aquatic board. The claim on appeal is: The ornamental design for a Transparent Aquatic Board as shown and described.

U.S. Patent No. Des. 378,692 issued April 1, 1997 containing Figures 1 to 7 and the written description of those figures.

In the reissue declaration accompanying the reissue application, the appellant states:

I believe the patent to be wholly or partly inoperative or invalid by reason of my claiming less than I had a right to claim, namely, an aquatic board as shown and described in Figs. 1 to 14 of the accompanying drawing.

The errors arose by reason of my and my attorney of record not realizing at the time of prosecuting the issued patent that broader claim coverage could be obtained than what was obtained. In analyzing the claim and drawings in the issued patent, it was determined to distinguish patentably over the prior art, that the fin and the mast box of the aquatic board were not required to be shown in full line, but only in broken lines, as environment, that the central portion of the board could be longer or shorter than originally shown and could thus be indicated broken with dashed lines to indicate that the exact length was not considered a distinguishing feature, and that the graphics of the alternative embodiment of Fig. 7 were not necessary to be present in just the form shown, but could be indicated in broken lines as environment without detracting from the patentable content of the design.

The errors arose without any deceptive intention on the part of the undersigned applicant.

The design claim stands rejected as follows:

- (1) under 35 U.S.C. § 112, first paragraph, as failing to comply with the description requirement thereof inasmuch as the disclosure of this reissue application directed to two additional embodiments shown in Figures 8-20<sup>2</sup> introduces new matter not supported by the disclosure of U.S. Patent No. Des. 378,692 as originally filed;
- (2) under 35 U.S.C. § 251 as based upon new matter added to the patent by inclusion of Figures 8-20 directed to two additional embodiments;
- (3) under 35 U.S.C. § 251 since it is not for the same invention as that disclosed in the original patent because of the inclusion of two additional design embodiments directed to just the bow and stern for an aquatic board and an aquatic board of indeterminate length;
- (4) under 35 U.S.C. § 171 as directed to more than a single patentably distinct design by claiming both combination/subcombination subject matter for an aquatic board in its entirety as well as a separate design embodiment directed to just bow and stern for an aquatic board; and
- (5) under 35 U.S.C. § 251 as lacking defect in the original application and lack of error in obtaining the original patent since the original patent would not have been granted to patentably distinct combination/subcombination designs under a single claim.

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<sup>2</sup> Figures 15 to 20 were added by the appellant to this reissue application in the response filed September 13, 2000 .

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 9, mailed December 7, 2000) and the answer (Paper No. 14, mailed October 10, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed July 20, 2001) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claim, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### **Rejections based on new matter**

We sustain the rejection of the design claim under 35 U.S.C. § 112, first paragraph, as failing to comply with the description requirement thereof, and the rejection of the design claim under 35 U.S.C. § 251 as based upon new matter.

The examiner determined (final rejection, pp. 2-4; answer, p. 4) that the design claim violated 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 251 by adding new

Figures 8-20 directed to a transparent aquatic board of indeterminate length. We agree.

The appellant's argue (brief, pp. 4-8) that new Figures 8-20 directed to a transparent aquatic board of indeterminate length are not new matter since nothing is being claimed in this reissue application that was not there originally. In support of what does or does not constitute new matter in the context of a design patent application the appellant cites In re Daniels, 144 F.3d 1452, 46 USPQ2d 1788, (Fed. Cir. 1998). We find the appellant's argument unpersuasive for the reasons that follow.

The court in Daniels permitted in a subsequent application the removal of leaf or surface ornamentation in a claimed design set forth in an earlier application because the court observed that the leaf ornamentation did not obscure the underlying design, all details of which were visible in the drawings of the earlier filed application. The leaf design was considered a "mere indicium that did not override the underlying design." Daniels, 144 F.3d at 1457, 46 USPQ2d at 1790-91. Further, the court observed that the subject matter remaining in the later application was "common to that of the earlier application." Id. Because the superimposition of the leaf design upon the underlying design did not obscure the underlying design itself, the court considered the appellant

in that case to have possessed the invention in the prior application that is claimed in the second application, thereby entitling the appellant in that case to benefit under 35 U.S.C. § 120 of the earlier filing date. We view Daniels as indicating basically that surface indicia is not a part of an initial design. The binding precedential value of Daniels would be that a logo or part number or the like may be removed, without being new matter, to the extent it may be fairly characterized as surface indicia not a part of the original or initial design.

The appellant's apparent position is bottomed upon an extension of this view such that if the design is "clearly visible" in the earlier design it may be claimed in any manner of combination and subcombination of elements in this design reissue application. We do not see any "clear visibility" test to be derived from Daniels beyond removal of surface ornamentation which did not obscure the underlying design itself, such as to permit the appellant here to file a reissue application and essentially carve out now something for which there was no possession within 35 U.S.C. § 112, first paragraph, in the underlying patent. Thus, the changing of the transparent aquatic board from one of determinate length as shown in Figures 1-7 to the transparent aquatic board of indeterminate length as shown in Figures 8-20 does not correspond to the removal of surface indicia according to Daniels. It is our view that Daniels does not stand for the proposition that the appellant is now permitted to remove elements or

parts of an original design without running afoul of the written description requirement of the first paragraph of 35 U.S.C. § 112. Thus, it is our determination that Figures 8-20 are drawn to new matter since they presently change the underlying patented design itself.

In view of the foregoing, the decision of the examiner to reject the design claim under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 251 based on new matter is affirmed.

**The rejections based on the claim not being to the same invention**

We will not sustain either the rejection of the design claim under 35 U.S.C. § 251 as not for the same invention as that disclosed in the original patent or the rejection of the design claim under 35 U.S.C. § 171 as directed to more than a single patentably distinct design.

In our view, the examiner has not established that either Figures 8 to 14 or Figures 15 to 20 are a patentably distinct design from Figures 1 to 7. Moreover, we agree with the appellant (brief, pp. 10-11) that Figures 8 to 20 do not present a design that is patentably distinct from the design shown Figures 1 to 7. Accordingly, the

decision of the examiner to reject the design claim under 35 U.S.C. § 171 and 35 U.S.C. § 251 as not being to the same invention is reversed.

**The rejection based on lack of defect**

We will not sustain the rejection of the design claim under 35 U.S.C. § 251 as lacking defect in the original application and lack of error in obtaining the original patent.

The reissue declaration clearly sets forth four defects in the original design patent. While one of those defects (i.e., that the central portion of the board could be longer or shorter than originally shown and could thus be indicated broken with dashed lines to indicate that the exact length was not considered a distinguishing feature) cannot be corrected based upon our decision above with respect to the new matter rejections, the examiner has not raised any objection to correcting the other three defects (i.e., the fin and the mast box of the aquatic board and the graphics of the alternative embodiment of Figure 7 were not required to be shown in full line, but only in broken lines, as environment). Thus, we conclude that there was a defect in the original application and an error in obtaining the original patent entitling the appellant to file a reissue application.



Since there is a reissuable error present in this application, the decision of the examiner to reject the design claim under 35 U.S.C. § 251 as lacking defect in the original application and lack of error in obtaining the original patent is reversed.

#### CONCLUSION

To summarize, the decision of the examiner to reject the design claim under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 251 based on new matter is affirmed and the decision of the examiner to reject the design claim under 35 U.S.C. § 171 and 35 U.S.C. § 251 on bases other than new matter is reversed.

Since at least one rejection of the appealed design claim has been affirmed, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

LORA M. GREEN  
Administrative Patent Judge

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Appeal No. 2002-0494  
Application No. 29/102,729

Page 11

THOMAS D. MACBLAIN  
GALLAGHER & KENNEDY  
2575 EAST CAMELBACK ROAD  
PHOENIX, AZ 85016

JVN/jg